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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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5514	7590	05/18/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	
			DATE MAILED: 05/18/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,016

Applicant(s)

ITO, MASAMICHI

Examiner

King Y. Poon

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless--

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or except that an international application filed under the treaty defined in section 351 (a) shall have the effects under this subsection of a national application published under 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (US 6,122,403).

Regarding claim 1: Rhoads teaches an image capture apparatus (the computer that is to reproducing an image, such as a video, column 72, lines 15-23, with added watermarks, column 69, lines 49-56, and the scanning device, column 69, lines 50-55) which records data of a captured image on a recording medium (the recording medium that stores the image file, column 69, lines 50-60, scanned by the image scanner; since the computer is loaded with the image file scanned by the image scanner, inherently, the computer must process a memory for storing the image file to prevent the image file from being lost) comprising: an image capture unit (scanning device, column 69, lines 50-55) adapted to capture an image; a recording unit adapted to record image data for the captured image on a recording medium (the recording medium that stores the image

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file, column 69, lines 50-60); a reproducing unit (Adobe Photoshop, column 72, lines 45, column 69, lines 33-40) adapted to reproduce the image data captured from the recording medium (the memory of the computer that is storing the image file, column 69, lines 49-56); an embedding unit (writer, column 69, line 34) adapted to embed specific information (e.g., Creator ID, column 69, line 42) into the image data using a digital watermarking technique (column 69, lines 32-35); an outputting unit (the output unit of the computer that transmits the image file, column 69, lines 49-55, to a local computer or network, fig. 43, column 72, lines 50-55, column 74, lines 10-13) adapted to output the image data including the specific information or the image data not including the specific information to the outside (the image downloaded may contain watermark or not containing watermark, column 70, lines 15-20); and a selection unit (the program of the computer that sense the OK selection and embedded the watermark into image data, column 73, lines 45-50, or cancel the process, and the software that downloads the image file to a local computer, column 69, lines 49-55, column 72, lines 50-55) adapted to select a first process (embed the watermark, column 73, lines 45-50) or a second process (abort the process, column 73, lines 45-50) in accordance with user's instruction, wherein when the first process is selected, the embedding unit embeds the specific information into the image data (column 73, lines 45-50) and the outputting unit outputs the image data including the specific information to the outside (column 72, lines 50-60, fig. 43); wherein, when the second process is selected, the embedding unit does not embed the specific information into the image data (column 73, lines 45-50)

and an outputting unit outputs the image data not including the specific information to the outside (column 72, lines 50-60, fig. 43).

Regarding claim 2: Rhoads teaches wherein the embedding unit is adapted to embed the specific information into the decompressed image data. (Column 71, lines 10-15).

Regarding claim 3: Rhoads teaches wherein the reproducing unit is adapted to reproduce the specific information from the recording medium. (Fig. 43, column 73, lines 7-15, teaches that the specific information/Creator ID is issued to a user one time; the Creator ID, in this case, has to be saved in the recording medium of the computer or lose it otherwise).

Regarding claim 4: Rhoads teaches wherein the reproducing unit is adapted to reproduce the specific information from another recording medium. (Fig. 43, column 73, lines 7-15, teaches that the specific information/Creator ID is from a MarcCentre database).

Regarding claim 13: Rhoads teaches wherein the apparatus generates the specific information when the image is captured (column 69, lines 50-56, column 72, lines 49-50).

Regarding claims 5-8, 14: Claims 5-8, 14 are claiming method steps for the apparatus discussed in claims 1-4, 13. Please see discussion on claims 1-4, 13.

Regarding claims 9-12, 15: Rhoads teaches to use a computer, running software programs (column 67, lines 55-62) for carrying out the method steps discussed in claims 1-4, 13. It is inherent that a software program is stored in a storage program.

Response to Arguments

3. Applicant's arguments filed on 3/1/2004 have been fully considered but they are not persuasive.

With respect to applicant's argument, on page 8, and the top of page 9 that Rhoads' image capturing apparatus is not the same as the image capturing apparatus as the applicant's invention because of the reason that the image capturing apparatus of Rhoads is the scanner, has been considered.

In reply: The examiner interprets the image capturing apparatus of Rhoads comprises of the image scanner as well as the computer (the computer that is to reproducing an image, such as a video, column 72, lines 15-23, with added watermarks, column 69, lines 49-56, and the scanning device, column 69, lines 50-55).

The American Heritage Dictionary of the English Language defines an apparatus as an integrated group of materials or devices used for a particular purpose.

A scanner is device and a computer is another device. Rhoads teaches to join the scanner device and the computer device together (integrated) to use for the purpose of embedding a watermark into a captured image.

Therefore, the interpretation of the image capturing apparatus of Rhoads by the examiner is supported by the American Heritage Dictionary of the English Language.

With respect to applicant's argument, on page 9, that Rhoads does not teach that the specific information, which is embedded in the image data, using digital

watermarking technique by the image capture apparatus, is generated when the image is captured by the image capture apparatus, has been considered.

In reply: Column 69, lines 50-56, column 71, lines 45-50, Rhoads, teaches to capture the image by scanning the image into an image file and when the image is captured, an watermark of specific information (such as film speed, exposure, column 69, line 30, or the photograph contains adult content, column 73, line 36) is embedded in the captured image.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

May 11, 2004

King Yau Poon